

**REMARKS**

Claims 1-10 are pending and rejected and claims 2-9 are objected to in the above-identified application.

For the sake of clarification, claims 1 and 10 have been amended to correct for minor informalities, grammatical and typographical errors, indefinite language terms (i.e., such as “if necessary”) and antecedent basis issues.

For example, in the interest of language clarification, claim 1 has been amended to: [1] delete the phrase “proviso that formula I” from the first proviso therein and instead recite the phrase “provided that”; and [2] to delete the term “with the proviso that . . .” from the second proviso therein and instead recite the phrase “further provided”.

Amended claim 1 now recites:

“provided that formula (I) compounds are not:

[3-(acetylamino)-4-cyclohexylphenyl]-butanedioic acid and 3-(acetylamino)-4-cyclohexylphenyl]-butanedioic acid diethyl ether; butanedioic acid [3-methoxy-4-(phenylmethoxy)phenyl]; or butanedioic acid [4-(phenylmethoxy)phenyl]; and

further provided that when R<sup>1</sup> is C<sub>4-12</sub>alkyl, Z is other than a bond, O or CH<sub>2</sub>, or physiologically functional derivatives thereof."

Claim 10 has been amended to delete the term "the" before the term "preparation" to remove antecedent basis issues. Amended claim 10 now recites: "A process for preparation of compounds of formula (I) as defined in claim 1 . . ."

Support for all claim and specification amendments are found in the originally filed specification and claims.

No new matter has been added to the claims or specification by amendment.

Applicants request consideration and entry into the record of the following amendments and remarks.

## **Information Disclosure Statement**

The Examiner states that the information disclosure statement ("IDS") filed on February 10, 2006 fails to comply with 37 C.F.R. §§ 1.97, 1.98 and MPEP § 609 as [1] the specification recites references not included in the IDS; and [2] the following references are not in the English language: DE 2023000, Bestmann et al., Cagniant et al., and Gotthardt et al.

Applicants have attached a new IDS, P.T.O. 1449 form and corresponding references herewith.

In particular, for the Examiner's consideration, applicants have cited on the aforementioned P.T.O. 1449 form, all relevant references identified in the originally filed specification, U.S. Patent 3,763,229 (i.e., English language equivalent to German Patent document DE 2023000 identified in IMPADOC) and English Language HCAPLUS Abstracts and English language translations of each of the Bestmann et al., Cagniant et al., and Gotthardt et al. references.

### Objections to the Specification

The Examiner has objected to and requested correction to the above-identified disclosure for: [a] various typographical and grammatical errors on page 3, lines 23-24 and line 33; and [b] lack of consistency in language in the method steps, i.e., "preparing" on page 5, lines 15-27 to page 6.

Applicants have obviated this objection by correcting for various typographical and grammatical errors by amending language on page 3, lines 23-24 and line 33 as indicated above under Amendments to the Specification section at page 2, *supra* and as follows:

"Suitably  $R^2$  represents  $CONH_2$  or  $COOH$  or  $CO_2CH_3$  ~~, such as  
 $CONH_2$ , should the second  $CONH_2$  group be deleted or should more  
preferably be kept?~~

Suitably Q represents ~~ub~~substituted unsubstituted aryl, such as unsubstituted phenyl.

Suitably Z represents a bond or O, ~~such as a bond.~~"

The above-identified specification at page 5, lines 13-27 to page 7, lines 1-6 also has been amended to correct for grammatical/typographical errors. Each of the process or method steps (A) to (E) recited in the aforementioned specification sections now are amended consistently to recite the gerund form of a verb.

In light of the above, applicants request that the above-identified rejections be withdrawn.

### Rejection Under 35 U.S.C. §112 2<sup>nd</sup> paragraphs

Claims 1 and 10 are rejected under 35 U.S.C. §112, 2<sup>nd</sup> para., for being indefinite and for failing to particularly point out and distinctly claim the invention.

The Examiner states that in claim 1, applicants "intended to say "is" rather than "in" as associated in the phrase ". . . proviso that  $R^2$  in [sic] . . ."

In response to the Examiner's rejection, applicants respectfully point out that in the February 10, 2006 Preliminary Amendment and as further amended herein (i.e., where the term "with the proviso that" is replace with the phrase "provided that") R<sup>2</sup> recites:

"R<sup>2</sup> is CONH<sub>2</sub>, CO<sub>2</sub>H, CO<sub>2</sub>R<sup>7</sup>, SO<sub>2</sub>R<sup>7</sup> or SO<sub>2</sub>NR<sup>8</sup>R<sup>9</sup>,  
provided that R<sup>2</sup> is not CO<sub>2</sub>R<sup>7</sup>, when X is CONH<sub>2</sub> . . ."

As the verb appears to be correctly set forth, applicants request clarification of the Examiner's rejection with regard to the variable term "R<sup>2</sup>".

The Examiner states as recited method steps in claim 10 are confusing, "applicant is requested to use consistency in reciting method steps by using the terms "for preparing" "or "preparing".

In accordance with U.S. Practice, applicants now have amended claim 10 to more clearly define method steps (A) to (E) as defined therein to be introduced, respectively, by a gerund or a verbal noun (i.e. with the "-ing" form of a verb).

Amended claim 10, now recites:

"A process for preparation of compounds of formula (I) as defined in claim 1, wherein the process comprises:

- (A) preparing a compound of formula (I), . . . by reacting a compound of formula (II) . . . with a reagent suitable to introduce the group R<sup>1</sup>; or
- (B) (i) preparing a compound of formula (I), . . . by reacting a compound of formula (III) . . . with a compound of formula (IV) . . .; and  
(ii) . . . optionally followed by ~~oxidation~~ oxidizing the Y group to the corresponding SO or SO<sub>2</sub> group as required; or
- (C) preparing a compound of formula (I), . . . by reacting a compound of formula (III), . . . with a compound of formula (V) . . .; or
- (D) preparing a compound of formula (I), . . . by reacting:
  - (i) a compound of formula (VI) . . . with an optionally substituted 5- or 6-membered aryl or heteroaryl nucleophile, which is a compound of formula (VII) . . . and
  - (ii) reducing and eliminating ~~of the~~ a resultant or product alcohol formed from step (i); and
- (E) optionally deprotecting compounds of formula (I) with a protecting group.

In light of the above, applicants request the above-identified rejections be withdrawn.

#### **Allowable Subject Matter**

Claims 2-9 are objected to as being dependent upon a rejected base claim, but would be allowable, if rewritten in independent form to include all of the limitations of the base claim and any intervening claims.

Applicants request that the above-identified objections to claims 2-9 be held in abeyance until the determination of patentable subject matter in the above-identified application.

**CONCLUSION**

In view of the above amendments and remarks, applicant believes that the claims of the present application are in condition for allowance and is earnestly solicited .

If any additional fees or charges are required authorization is hereby granted to charge any necessary fees to Deposit Account No. 19-2570 accordingly.

Should the Examiner have any questions or wish to discuss any aspect of this case, the Examiner is encouraged to call the undersigned attorney at the number below.

Respectfully submitted,



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Grace C. Hsu  
Attorney for Applicant  
Registration No. 51,336

GLAXOSMITHKLINE  
Corporate Intellectual Property-UW2220  
P.O. Box 1539  
King of Prussia, PA 19406-0939  
Phone: (610) 270-4650  
Fax: (610) 270-5090  
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